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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,425	12/01/2003	C. Douglass Thomas	CDT002DC1	1048
7590 05/06/2004				
C. Douglass Thomas 1193 Capri Drive Campbell, CA 95008		EXAMINER CHENG, JOE H		
		ART UNIT 3713 PAPER NUMBER		
DATE MAILED: 05/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,425	Applicant(s) THOMAS, C. DOUGLASS	
	Examiner Joe H. Cheng	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input checked="" type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/1/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The term "This application is a continuation application of co-pending prior U.S. Application No. 10/273,430, filed October 18, 2002, which is a continuation application of 09/542,999, filed April 4, 2000 and now U.S. Patent 6,514,084, which is a continuation application of 09/253,851, filed February 22, 1999 and now U.S. Patent 6,086,382, which is a continuation application of U.S. Application No. 08/810,547, filed on March 3, 1997 and now U.S. Patent 5,885,087, which is a continuation application of U.S. Application No. 08/315,976, filed on September 30, 1994 and now U.S. Patent No. 5,618,182, the disclosures of which are incorporated herein by reference." On Pg. 1, lines 7-16 should be recited as --This application is a continuation application of U.S. Application Serial No. 10/273,430, filed October 18, 2002, now abandoned, which is a continuation application of U.S. Application Serial No. 09/542,999, filed April 4, 2000, now U.S. Patent No. 6,514,084, which is a continuation application of U.S. Application Serial No. 09/253,851, filed February 22, 1999, now U.S. Patent No. 6,086,382, which is a continuation application of U.S. Application Serial No. 08/810,547, filed on March 3, 1997, now U.S. Patent No. 5,885,087, which is a continuation application of U.S. Application Serial No. 08/315,976, filed on September 30, 1994, now U.S. Patent No. 5,618,182, the disclosures of which are incorporated herein by reference.--, so as to clarify the status.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

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2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “wherein the question is associated with a topic, and wherein the substantive information pertains to detailed information on the topic of the question, and” should be delete, because it is the duplicate of claim 16, so as to clarify the confusion.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-26 of U.S. Patent No. 6,514,084 B1 (hereinafter as Thomas). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of the "method for improving a user's performance on multiple choice examination" (as per claims 1-20), are the obvious alternative languages since these merely describe the "computer readable medium containing computer instructions that are useful for improving a user's performance on multiple choice examination", (as per claims 10-26 Thomas) in boarder terms. Hence, the instant claim does not differ from the scope of the patented claims 1-4. In 214 USPQ 761, *In re Van Ornum*

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and *Stang*, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

Allowable Subject Matter

7. Claim 21 is allowed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Swanson et al (U.S. Pat. No. 5,657,256) - note Figs. 1(a)-2;

Vanko et al (U.S. Pat. No. 5,508,911) - note Figs. 1-25;

Poor (U.S. Pat. No. 5,452,379) - note Figs. 1-12;

Sack et al (U.S. Pat. No. 5,259,766) - note Figs. 1-5;

Schulz (U.S. Pat. No. 5,233,531) - note Figs. 1-6;

Ferris et al (U.S. Pat. No. 5,011,413) - note Figs. 1-5;

Nichtberger et al (U.S. Pat. No. 4,882,675) - note Figs. 1-40;

Manning et al (U.S. Pat. No. 4,547,161) - note Figs. 1A-4C;

Sokolski et al (U.S. Pat. No. 3,900,961) - note Figs. 1-10.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue. - Fri..

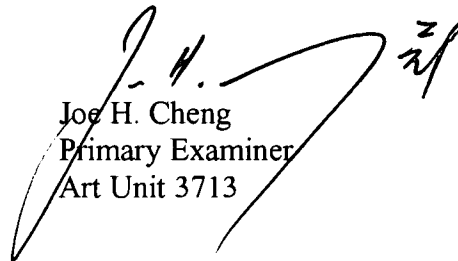
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703)308-1327. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703)872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Joe H. Cheng
April 24, 2004



Joe H. Cheng
Primary Examiner
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